

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of:	§	Attorney Docket No.:
Hsu, et al.	§	TSMC2002-1130/ 24061.50
	§	
Serial No.: 10/712,880	§	Customer No. 42717
	§	
Filed: November 13, 2003	§	Group Art Unit: 3625
	§	
For: METHOD AND SYSTEM TO LINK	§	Examiner: Levine, Adam
ORDERS WITH QUOTATIONS	§	
	§	Confirmation No.: 2319
	§	
	§	

Mail Stop Appeal Brief - Patents
Commissioner for Patents
P.O. Box 1450
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Sir:

REPLY BRIEF

A Notice of Appeal was received by the Office on July 10, 2006, a Notice of Panel Decision From Pre-Appeal Brief Review was issued on August 9, 2006, and an Appeal Brief was filed on September 11, 2006. The Examiner issued an Examiner's Answer on November 26, 2007. This Reply Brief is now being filed pursuant to the provisions of 37 C.F.R. §41.41. A separate transmittal letter containing an appropriate certificate of mailing serves to transmit this Reply Brief.

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STATUS OF CLAIMS

Claims 1-2, 4-12, 14-20, and 22-34 are all pending, have all been finally rejected, and are all on appeal here. Claims 3, 13, and 21 have been canceled. Claims 1-2, 4-12, 14-20, and 22-34 are set forth in the Claims Appendix of Applicants' previously-filed Appeal Brief, and have not changed since filing of the Appeal Brief.

GROUND OF REJECTION TO BE REVIEWED ON APPEAL

The grounds of rejection to be reviewed on appeal were set forth on page 9 of Applicants' previously-filed Appeal Brief, and have not changed. These grounds of rejection are set forth again below, without change, in order to comply with a requirement set forth in MPEP §1208. In particular, the grounds of rejection to be reviewed on appeal are:

1. Whether Claims 1, 2, 4-12, 14-20, and 22-31 are unpatentable under 35 U.S.C. §103(a) as obvious in view of a proposed combination of U.S. Patent No. 4,799,156 to Shavit et al ("Shavit") and U.S. Publication No. 2002/0161672 to Banks et al. ("Banks").

2. Whether Claims 32-34 are unpatentable under 35 U.S.C. §103(a) as obvious in view of a proposed combination of Shavit, Banks, and U.S. Publication No. 2002/0029171 to Senior ("Senior").

ARGUMENT

The arguments that follow are supplementary to the arguments previously set forth in Applicants' Appeal Brief.

In the Examiner's Answer, Section (9) on pages 3-10 is a verbatim reproduction of text that previously appeared on pages 3-9 of the final rejection mailed on April 7, 2006. This material has already been addressed in detail in the Arguments section of Applicants' Appeal Brief. However, to further elucidate the Applicant's arguments, and in light of recent case law, supplementary discussion is included below.

The Examiner cites to an *extensive* portion of Shavit as providing a quotation database and a product database (e.g., citations to approximately 200 lines of Shavit are provided as support for disclosure of a quotation database). Shavit discloses, for example, pricelists, databases including inventory, and general descriptions of the existence of a data base. (Col. 29 line 65; col. 25 line 66 – col. 26 line 1; abstract). Even assuming, for the sake of argument, that Shavit discloses a quotation database and a product database, as asserted by the Examiner, it is clearly apparent that Shavit does not disclose a mapping database. Moreover, a mapping database record that is updated with information from a quotation database and a product database is not disclosed. Yet still, an order price is not disclosed as being calculated from a mapping database record. These are elements of Applicant's independent claims.

The Examiner provides citations to an extensive portion of Shavit as providing a mapping database including “see at least column 24 line 53 – column 25 line 9, column 31 line 32 – column 32 line 9, column 36 lines 22-53, column 40 lines 28-53.” The Examiner continues to assert that determining an order price based on the mapping database record is provided in the same portions of Shavit. In these generally cited approximately 128 lines of Shavit, the Applicants find no disclosure of a mapping database. At column 24 line 53 – column 25 line 9, Shavit provides a description of handling billing for use of the disclosed system (e.g., if access is

to a local database service). At column 31 line 32 – column 32 line 9, provided is a description of an “automatic information service” that “provides application programs for accessing the distributor data base and provides data processing functions on behalf of the distributor when dealing with other parties.” Col. 31, lines 2-5. Shavit continues to provide that these functions include maintaining a promotional interactive session, answering customer inquiries and generating online reports, automatic order amendments, automatic sales order entry, and automatic bidding. See Fig. 21. Column 36 lines 22-53 provide a description of freight carrier operations that comprise preparation and review of manually and automatically generated bids; entry, amendment, and review of reservation records; entry, retrieval, and review of documentation; entry and review of scheduling and status information; management of bulletin board offerings, and operation of submission of invoices and statements through the system. At column 40 lines 28-35, Shavit discloses transaction means including requesting and receiving price quotations, mortgaging inventory, placing and amending orders, direct shipment instructions and so forth. Thus, it is clear that none of the cited portions of Shavit asserted by the Examiner provide a mapping database or mapping database record as found in all claims.

Additionally, and despite the Examiner’s earlier assertion however, the Examiner subsequently agrees that Shavit “does not disclose updating a mapping database record...retrieving a mapping database record...and calculating an order price...” Examiner’s Answer pgs. 7-8, Final Office action pgs. 6-7. The Examiner instead asserts that this is provided by Banks. The Applicants’ respectfully disagree with this assertion. Banks discloses only a method of comparing previously “downloaded” data from an e-catalog database with subsequent downloads of the e-catalog database data. [0017] That is, data from the e-catalog is first downloaded and stored by an EDI user and subsequently downloaded revisions, as needed, are incorporated into the previously stored data using a comparison table (“cross reference (data mapping) tables”) to determine the revisions/updates needed. [0019]. Specifically, Banks provides a system 31 which synchronizes price, vendor, produce and other information between the unit 13 (e-catalog database) and unit 17 database (purchasing system) by updating the

purchasing system (17). [0019]. Clearly synchronization by cross reference tables of two databases, by updating one of the two databases, does not provide disclosure for a mapping database that is itself updated with information from two databases. Moreover, it certainly does not provide a mapping database updated with information from a quotation database and a product database associated with the product, as claimed.

MPEP 2143.03 states that “[a]ll words in a claim must be considered in judging the patentability of that claim against the prior art.” Quoting *In re Wilson*, 424 F.2d 1382, 1385 (CCPA 1970). However, in the present matter as illustrated above, the Examiner has not shown that all words in the claim have been considered. The claimed combination of Shavit and Banks fails to provide a prima facie case of obviousness.

Section (10) of the Examiner's Answer is a response to the arguments presented in Applicants' Appeal Brief. The Examiner begins his response with a citation to *KSR Int'l. Co. v. Teleflex Inc.*, 550 U.S. at __, 82 USPQ2d 1385 at 1391 (2007). Applicants note that in *KSR*, the Court stated that "a patent composed of several elements is **not proved obvious merely by demonstrating that each of its elements was, independently, known in the prior art.** Although common sense directs one to look with care at a patent application that claims as innovation the combination of two known devices according to their established functions, it can be important to identify a **reason that would have prompted a person of ordinary skill in the relevant field to combine the elements in the way the claimed new invention does.** This is so because inventions in most, if not all, instances rely upon building blocks long since uncovered, and claimed discoveries almost of necessity will be combinations of what, in some sense, is already known." *KSR Int'l. Co. v. Teleflex Inc.*, 127 S. Ct. 1727, 1741 (2007) (emphasis added).

The Applicants agree with the Examiner's response that one cannot show nonobviousness by attacking references individually where rejections are based on combinations of references. However, Applicants have clearly shown in the Appeal Brief and above, that neither Banks nor Shavit, alone or in combination, provide a mapping database, updating a mapping database record with information from a quotation database and a product database. Nor do the references, alone or in combination, provide retrieving a mapping database record from the mapping database and calculating an order price based on the mapping database.

The Examiner in his response also asserts that the combination of Shavit and Banks is "entirely predictable." Examiner's Answer, page 12. The Applicants disagree; the proposed combination of Shavit and Banks is clearly not predictable, and improper. The Examiner appears to equate a conclusion that both Shavit and Banks include a database associated with a product information to provide predictability in their combination. The Applicant's respectfully disagree. Furthermore, *KSR* teaches that when combining elements from different references, it is important to determine whether the element is performing "the same function it had been known

to perform.” *KSR* at 1740. It is clear that the data mapping tables of Banks should not be combined with the method of Shavit in the manner proposed by the Examiner because the known function of data mapping tables is changed. More particularly, the data mapping tables of Banks provide synchronization of data previously stored with updated data, that is, their purpose is to take into account updates in the e-catalog database, by revising previously downloaded data from the e-catalog database as described above. In contrast to this functionality, the Examiner proposes the data mapping tables function as a mapping database. Thus, the Examiner asserts in his combination of Shavit and Banks that the data mapping tables of Banks themselves be updated from information from two databases – a quotation database and a product database. This is clearly not the function of the data mapping tables of Banks, and in fact, destroys their function of providing synchronization between two databases by updating one of the databases

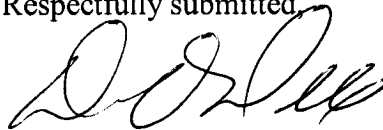
Since this modification of the Banks patent application clearly destroys the purpose or function of the invention disclosed in the patent, one of ordinary skill in the art would not have found a reason to make the claimed modification. Thus, for this reason alone, the Examiner’s burden of factually supporting a *prima facie* case of obviousness has clearly not been met, and the rejection under 35 U.S.C. §103 should be withdrawn. Furthermore, MPEP 2143.01 (III) states that the “mere fact that references can be combined does not render the resultant combination obvious unless the results would have been predictable to one of ordinary skill in the art.” Clearly combination of references in a manner such that the purpose of a reference is destroyed does not present a predictable result.

After careful consideration of the Examiner's Answer, Applicants still believe that the arguments presented in Applicants' Appeal Brief are accurate, and very clearly demonstrate why the rejections of the pending claims are defective. The Applicants also provide the arguments presented above clearly illustrating the rejections are erroneous.

IX. CONCLUSION

For reasons discussed above, it is respectfully submitted that the rejections of pending Claims 1-2, 4-12, 14-20, and 22-34 are all erroneous. Accordingly, it is respectfully requested that the Board reverse the claim rejections.

Respectfully submitted,



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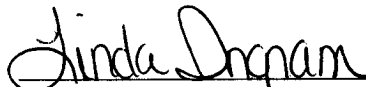
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Enclosures: None

Certificate of Service

I hereby certify that this correspondence is being filed with the U.S. Patent and Trademark Office via EFS-Web on January 4, 2008


Linda Ingram